

REMARKS

Claims 1, 3-7, 9-16, 18-27, and 29-32 stand rejected. Claims 1, 3-7, 9-16, 18-27, and 29-32 are pending. Applicants request reconsideration of the pending claims.

I. Interview Summary

Applicants thank the Examiner for the telephonic interview on May 22, 2009. Independent claim 1 was discussed in light of Takayama (EP 0950 968 A1). The remarks below reflect the subject matter discussed during the interview.

II. Claim Rejections – 35 USC 103

Claims 1, 3-7, 9-13, 15-16, 18-27, 29-31 were rejected under 35 USC 102(b) as being anticipated by Takayama in view of Okkonen et al. (US 2004/0166839 A1). Although the Office Action states that these claims are rejected under 35 USC 102(b), Applicants assume that the Examiner had intended for this to be a rejection under 35 USC 103.

A. Takayama Discloses Deleting All Data Held in RAM 1502

MPEP 2143.01.VI states, “if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”

The above MPEP section cites to *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), and briefly sets out the facts of the case as follows:

Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The

court reversed the rejection holding the ‘suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.’ 270 F.2d at 813, 123 USPQ at 352.”

In the present application, independent claims 1, 7, 15, and 27 recite that the uploaded data is left in the memory of the terminal **even when the subscriber information card is dismounted from the wireless communication terminal.** In contrast, Takayama explicitly discloses that all data held in the memory of the terminal is deleted when the SIM card is removed from the terminal after data has been uploaded from the terminal to the user information server. In particular, paragraph [2108] of Takayama explicitly discloses that “mobile user terminal 13900 **deletes all the data held in the RAM 1502,**” when the SIM card is removed from the terminal after data has been uploaded from RAM 1502 of the mobile terminal 13900 to the user information server 902. (Emphasis added.)

Thus, similar to the facts of *In re Ratti*, Takayama explicitly discloses deleting all data from the memory of the terminal when the SIM card is removed, whereas claims 1, 7, 15, and 27 recite leaving data in the memory of the terminal when the subscriber information card is dismounted from the wireless communication terminal. Thus, the Examiner’s suggestion to modify Takayama, whether in view of Okkonen or any other art of record, impermissibly requires changing the principle of operation of Takayama.

In particular, as discussed in more detail below, Takayama only discloses authenticating the user of the SIM card, but does not disclose authenticating the user of the terminal device. Thus, if data is not deleted from the memory of the terminal device in the system disclosed in Takayama, another user could potentially insert their SIM card into the terminal device and upload the data from the memory to their server. (Note, this potential risk is described on page 4, lines 11-16, of the present specification.) Presumably to prevent this from happening, Tayakaya requires that all data be deleted from the memory of the terminal when the SIM card is removed. Thus, the Examiner’s

suggestion to modify Takayama to not include this feature requires changing the principle of operation of Takayama.

Additionally, the disclosure of Okkonen does not address this shortcoming. In particular, Okkonen discloses detecting when a SIM card has been removed, but it does not disclose how to secure data that remains on the terminal device, when the SIM card has been removed.

Thus, Applicants assert that the Examiner has not established a prima facie case of obviousness.

B. Takayama Reference Only Discloses Confirming Authentic User of SIM Card

Claims 1, 7, 15, and 27 recite that uploading from the terminal is allowed to be executed at least under conditions that the user is confirmed to be:

- a) an authenticated user of said subscriber information card; AND
- b) an authenticated user of the terminal.

In the Office Action, the Examiner asserts that, “[in Takayama] uploading occurs when authenticating the user after entering a code number that matches a code number stored in the nonvolatile memory.” The Examiner cites to paragraphs [2111-2112] of Takayama for support.

In citing to paragraph [2111], the Examiner has failed to mention that the nonvolatile memory is that of the SIM card 14000. In particular, paragraph [2111] states, “the code number stored in the nonvolatile memory of the SIM card 14000 is compared with the code number that was entered [by the user].” (Emphasis added.)

Thus, Takayama discloses confirming that the user is the authenticated user of the subscriber information card. However, Takayama does not disclose confirming that the user is the authenticated user of the terminal. Moreover, as discussed above, Takayama discloses deleting

all data on the terminal, when the SIM card is removed. Thus, there is no motivation to modify Takayama to authenticate the user of the terminal.

For at least these two independent reasons, Applicants assert that claims 1, 7, 15, and 27 are allowable over Takayama and Okkonen. Applicants also assert that claims 3-6, 9-13, 16, 18-26, and 29-31 are allowable for at least the reason that they depend from allowable independent claims.

Claims 14 and 32 were rejected under 35 U.S.C. 103(a) as being unpatentable over Takayama and Okkonen in view of US 2005/0125344 (Utsumi).

Claims 14 and 32 depend from independent claims 7 and 27, respectively. As discussed above, Applicants assert that claims 7 and 27 are allowable over Takayama and Okkonen for at least the reason that Takayama fails to disclose or suggest confirming that a user is an authenticated user of the terminal from which data is to be uploaded or on which the subscriber information card is mounted. Utsumi also fails to disclose or suggest this limitation. In particular, Utsumi discloses verifying personal information in paragraph [0011], but does not disclose or suggest confirming that a user is an authenticated user of the terminal from which data is to be uploaded or on which the subscriber information card is mounted. Thus, Applicants assert that claims 14 and 32 are allowable over the combination of Takayama, Okkonen, and Utsumi.

III. Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No.: 03-1952** referencing **Docket No.: 448252001800**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: May 26, 2009

Respectfully submitted,

By /Peter J. Yim/

Peter J. Yim

Registration No.: 44,417
MORRISON & FOERSTER LLP
425 Market Street
San Francisco, California 94105-2482
Telephone: 415.268.6373
Fax: 415.268.7522